

Appl. No. 10/644,280
Amdt. dated Dec. 17, 2007
Reply to Off. Act. dated Sept. 7, 2007

RECEIVED
CENTRAL FAX CENTER
DEC 17 2007

REMARKS/ARGUMENTS

1. Claims 6, 7, 9, 12-18, 24, and 28-43 are pending in the present application. The Examiner rejected claims 32, 33, 36-39, 40, and 43 under 35 U.S.C. § 102(b) as being anticipated by Di Meo et al. (U.S. Patent No. 2,823,056). Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Meo et al. (hereinafter "Di Meo") in view of Bartlett et al. (U.S. Patent No. 5,199,756). Claims 32-43 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 34, 41, and 42 were indicated as being allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph. Claims 6, 7, 9, 12-18, 24, and 28-31 were indicated as being allowed. Reconsideration of this application is respectfully requested in view of the amendments and/or remarks provided herein.

Rejection under 35 U.S.C. § 112, second paragraph

2. Claims 32-43 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner indicated that it is unclear whether Applicant is claiming only a cable tray or an entire cable tray system in claims 32-43, but has assumed that Applicant is claiming a cable tray based on the express language of the preamble of claim 32. Responsive to this rejection, Applicant has amended claims 34, 36, 37, and 41 to clarify that the "two parallel sections" of the connector receiving member and/or connector receiving element are configured to at least receive at least a portion of a fastener in the respective space therebetween. Thus, as amended, the fastener recited in the preambles of claims 34, 36, 37, and 41 is not part of the body of each claim. As a result, the claims are now more clearly directed to a cable tray as stated in the preambles of claims 34 and 41, which, of course, can form part of a cable tray system.

Claim 32 has been amended to include the limitations of claim 35 and will be addressed in more detail below with respect to the rejection of claim 35. However, with respect to the rejection of claim 32 under 35 U.S.C. § 112, second paragraph, the amendment to claim 32 overcomes such rejection because the amendment requires that the two parallel sections of the

Appl. No. 10/644,280
Amdt. dated Dec. 17, 2007
Reply to Off. Act. dated Sept. 7, 2007

connector receiving member recited in such claim be separated and configured so as to receive and snugly engage a head of a carriage bolt such that rotation of the carriage bolt is prevented during threading of a nut onto the carriage bolt. Thus, claim 32 no longer includes the language indicated as being indefinite by the Examiner.

Claims 33, 35, 36, 40, and 43 have been amended to depend from claim 34 instead of claim 32. Additionally, claims 37-39 depend from claim 36. Consequently, the amendments to claims 34 and 41 overcoming the rejection under 35 U.S.C. § 112, second paragraph, are equally effective to overcome the rejections of claims 33 and 35-43 under 35 U.S.C. § 112, second paragraph.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejection of claims 32-43 under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 102(b)

3. Claims 32, 33, 36-39, 40, and 43 were rejected under 35 U.S.C. § 102(b) as being anticipated by Di Meo. As explained in detail in Applicant's prior responses, Applicant strongly disagrees with the Examiner's characterization of Di Meo in view of the express recitations of Applicant's claims. Nevertheless, in order to move prosecution forward and mitigate further costs of prosecution, but not for any reason related to patentability, Applicant has amended claims 33, 35, 36, 40, and 43 to depend from claim 34, which claim was indicated as being allowable if amended to overcome the rejection thereof under 35 U.S.C. § 112, second paragraph. As detailed above, claim 34 has been amended to overcome the rejection under 35 U.S.C. § 112, second paragraph. Additionally, since claims 37-39 depend from claim 36, they also depend from claim 34. Therefore, in view of the Examiner's indication of allowability of claim 34, Applicant submits that claims 33, 35-40 and 43 are allowable over the references of record.

With respect to claim 32, said claim has been amended to include the recitations of original claim 35. By the Examiner's own concession, Di Meo fails to disclose each and every limitation of claim 32, as amended, because Di Meo does not teach every limitation of original claim 35. As a result, Applicant requests that the rejection of claim 32 under 35 U.S.C. § 102(b) be withdrawn. Applicant's amendment of claim 32 is being made merely to move prosecution

Appl. No. 10/644,280
Amdt. dated Dec. 17, 2007
Reply to Off. Act. dated Sept. 7, 2007

forward and to mitigate further costs of prosecution, but is not being made for any reason related to patentability. Applicant has detailed his position regarding the impropriety of the Examiner's application of Di Meo to the recitations of claim 32 in Applicant's prior responses and, for the sake of brevity, will not repeat them here.

In view of the foregoing, Applicant respectfully requests that claims 33, 35-40 and 43 be passed to allowance and that the rejection of claim 32 under 35 U.S.C. § 102(b) be withdrawn.

Rejection under 35 U.S.C. § 103(a)

3. Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Meo in view of Bartlett et al. (hereinafter "Bartlett"). In particular, the Examiner concedes that Di Meo fails to disclose a connector receiving member formed of wire, but asserts that Bartlett discloses a connector fabricated from a functional equivalent of wire. In other words, the Examiner has repeated the rejection of claim 35 made in the prior Office Action dated March 22, 2007. Without commenting on the particulars of the Examiner's analysis of a wire-fabricated connector receiving member, Applicant *again* submits that such analysis is completely irrelevant to the claim limitations of claim 35 and, therefore, disagrees with the Examiner's rejection of claim 35 in view of the cited references. As noted above, Applicant has amended claim 32 to include the limitations of claim 35. As a result, Applicant's arguments distinguishing claim 35 from Di Meo and Bartlett are equally applicable to distinguish claim 32 from the cited references.

As stated in Applicant's response dated June 19, 2007, the limitations of claim 35 further define the structural configuration of the two parallel sections of the connector receiving member recited in claim 32. In particular, claim 35 requires the two parallel sections of the connector receiving member to be separated and configured "so as to receive and snugly engage a head of [a] carriage bolt such that rotation of the carriage bolt is prevented during threading of a nut onto the carriage bolt." Applicant's claim 32, as amended to include the limitations of claim 35, does not reference the use of any wire. As a result, the Examiner's analysis of whether the sheet metal locking clip (20) disclosed in Bartlett is functionally equivalent to a wire is completely *irrelevant* to the limitations recited in Applicant's claim 32. The Examiner has not identified and, upon review of Di Meo and Bartlett, Applicant has not found any disclosure or suggestion in either

Appl. No. 10/644,280
Amdt. dated Dec. 17, 2007
Reply to Off. Act. dated Sept. 7, 2007

reference of a connector receiving member (or equivalent structure) configured with the structural limitations expressly recited in Applicant's claim 35, which limitations have now been incorporated into claim 32.

Therefore, in view of the foregoing deficiencies of Di Meo and Bartlett, Applicant submits that the cited references, whether taken alone or in combination, fail to disclose or suggest the subject matter recited in Applicant's claim 32, as amended to include the limitations of claim 35. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 35 (and equivalently claim 32) under 35 U.S.C. § 103(a) and pass claim 32 to allowance.

Allowed Claims

4. Applicant would like to thank the Examiner for indicating the allowability of claims 6, 7, 9, 12-18, 24, and 28-31 as previously presented. Applicant would also like to thank the Examiner for indicating the allowability of claims 34, 41, and 42 if rewritten to overcome the rejection of said claims under 35 U.S.C. § 112, second paragraph. Applicant further requests the allowance of claims 32, 33, 35-40, and 43 for the reasons set forth above.

Comments on Statement of Reasons for Allowance

5. In the Examiner's prior statement of reasons for allowance as inherently repeated in the present Office Action by virtue of the Examiner's direction on page 5 of the present Office Action to "see previous action", the Examiner unnecessarily focused on the wire construction of the connector receiving element and the connector receiving member, as well as on the overall cable tray system. Applicant again respectfully objects to the unnecessarily narrow focus of the Examiner's statement and submits that the express recitations of the claims themselves, as construed in accordance with applicable law, define the true scope of Applicant's invention. As stated in Applicant's response dated June 19, 2007, the only claims that require the connector receiving member and/or the connector receiving element to be wire are claims 12-18 and 28, and the only claims directed to the entire cable tray system are claims 12-18 and 28-30. The remaining allowed and allowable claims do not include the "wire" limitation, nor are they directed to the entire cable tray system. As a result, Applicant submits that such remaining

Appl. No. 10/644,280
Amdt. dated Dec. 17, 2007
Reply to Off. Act. dated Sept. 7, 2007

allowed and allowable claims are allowable for the reasons set forth in detail in the extensive prosecution history of the present application, and not because any elements of the claims are limited to being made of wire or are necessarily part of a cable tray system.

6. The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the instant application. Please charge any necessary fees associated herewith, including extension of time fees (if applicable and not paid by separate check), to the undersigned's Deposit Account No. 50-1111.

Respectfully submitted,

By: 

Daniel C. Crilly
Reg. No.: 38,417
Attorney for Applicant
BRINKLEY, MORGAN ET AL.
200 East Las Olas Blvd., Suite 1900
Ft. Lauderdale, FL 33301
Phone: (954) 522-2200/Fax: (954) 522-9123
Email: daniel.crilly@brinkleymorgan.com

G:\WPFILES\clients\Wutec\03468-PAT-CABLE TRAY\03468 Amend.12.17.2007.doc